

REMARKS

Claim Amendments

The claims have been amended to limit the claimed invention to antibodies that selectively bind to a CDN-1 protein consisting of SEQ ID NO:7. The amendments merely reduce the issues in the application and are intended to expedite allowance of the claims. Applicants expressly reserve their right to pursue the subject matter cancelled from this application in a continuation application.

Rejoinder

It is noted that rejoinder is still requested for the method Claims 69 and 38, upon allowance of the referenced product claims. Claims 69 and 38 refer to Claim 60 and therefore contain all of the limitations of the product claims.

Rejection of Claims 32, 59, 61-63, and Claims 60 and 66-67 Under 35 U.S.C. § 102(e):

The Examiner has maintained the prior rejection of Claims 32, 59, and 61-63 and has rejected Claims 60 and 66-67 under 35 U.S.C. § 102(e), contending that these claims are anticipated by U.S. Patent No. 5,672,686, for the reasons of record.

Initially, it is noted that Claims 32, 59, 61-63 and 66 have been cancelled and so the rejection of these claims is now moot. With regard to Claims 60 and 67, Applicants traverse this rejection and submit that the '686 patent is not available as prior art against Claims 60 or 67. Claim 60, which was rewritten in the last response to be an independent claim, and the subject matter claimed therein, have not previously been rejected under 35 U.S.C. § 102(e), and it is not clear to Applicants from the Examiner's reference to the "reasons of record" why this claim is now rejected. The Examiner has previously acknowledged in Paper No. 11, page 3, that "claims drawn to antibody to Cdn-1 are not rejected under 35 U.S.C. § 102(e)". The present application claims priority back to U.S. Patent Application 08/160,067, filed November 30, 1993, which fully describes Cdn-1 having the sequence of SEQ ID NO:7, as well as antibodies, including monoclonal antibodies, that bind to this protein, and methods of detecting the presence of a Cdn protein in a sample using the antibody (referring to method Claims 69 and 38). The earliest priority date for the '686 patent is August 9, 1994, which

is several months after the priority date for the present application. Therefore, the '686 patent is not available as prior art against Claims 60 or 67 (or against method Claims 69 and 38).

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 32, 59, 61-63, and Claims 60 and 66-67 under 35 U.S.C. § 102(e).

Rejection of Claims 32, 59-63, and 66-67 Under 35 U.S.C. § 112, First Paragraph:

The Examiner has rejected Claims 32, 59-63, and 66-67 under 35 U.S.C. § 112, first paragraph, contending that the specification does not contain a sufficient written description of the claimed invention. The Examiner specifically asserts that the claims as written refer to antibodies that bind to proteins *comprising* the recited sequences, whereas the Examiner contends that the specification only sufficiently describes antibodies that bind to proteins *consisting of* the recited sequences. As discussed above, Claims 32, 59, 61-63 and 66 have been cancelled. Claim 60 has been amended to recite an antibody that binds to a Cdn-1 protein consisting of SEQ ID NO:7, which is believed to address the Examiner's concern. Claim 67 depends from Claim 60.

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 32, 59-63, and 66-67 under 35 U.S.C. § 112, first paragraph.

Applicants have attempted to address all of the Examiner's rejections as set forth in the June 7 Office Action, and Applicants submit that the claims are in a condition for allowance. In the event that the Examiner still has concerns regarding the pending claims, a telephone call to the below-named agent to expedite prosecution is respectfully requested.

Respectfully submitted,

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Date: September 22, 2004